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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/718,164	11/21/2000	Koji Hayashi	10449-027001	8739
26161	7590	11/23/2005	EXAMINER	
FISH & RICHARDSON PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			DINH, TAN X	
			ART UNIT	PAPER NUMBER
			2653	

DATE MAILED: 11/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/718,164		HAYASHI, KOJI	
	Examiner		Art Unit	
	TAN X. DINH		2653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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- 1) The notification filed 11/07/2005 is acknowledged.
- 2) The I.D.S filed 12/22/2004 and 1/31/2005 have been considered by the Examiner. However, the Japan and/or foreign document(s), if they have not been written in English, are considered to the extent that could be understood from the English Abstract and the drawings.

Form PTO-1449 or PTO/SB/08 is(are) attached herein.

- 3) The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970) and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed Terminal Disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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4) Claims *1 and 2* are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims *1 and 2* of co-pending Application No. 11/178,889. Although the conflicting claims are not identical, they are not patentably distinct from each other because: the difference between claims *1 and 2* in this instant application and claims *1 and 2* of copending Application No. 11/178,889 is that one recites a data recorder (preamble) and the other recites a control circuit for data recorder. However, this difference is not a patentable weight since the body of these claims recite the same structures and/or functions with each other and this would not make them a patentable distinction.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5) Claims 3-6 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3-6 of co-pending Application No. 11/178,889. Although the conflicting claims are not identical, they are not patentably distinct from each other because: the difference between claims 3-6 in this instant application and claims 3-6 of

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copending Application No. 11/178,889 is that one recites a buffer memory and the other is not. However, buffer memory are old and widely used in the recording art for temporary storing the recording data during recording or reproducing processes. Whether the buffer memory is positive recited in the body of the claim, found in the preamble of the claim or omitted is merely a selection between combination and subcombination of elements used in overall system and that would not making them patentable distinction.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6) Claim 7 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 7 of co-pending Application No. 11/178,889. Although the conflicting claims are not identical, they are not patentably distinct from each other because: the different between claim 7 in this instant application and claims 7 of copending Application No. 11/178,889 is that one recites a data recorder (preamble) and the other recites a control circuit for data recorder. However, this different is not a patentable weight since the body of these claims recite the same structures and/or

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functions with each other and this would not make them a patentable distinction.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7) Claims 8-10 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 3-6 of co-pending Application No. 11/178,889. Although the conflicting claims are not identical, they are not patentably distinct from each other because: the difference between claims 3-6 in this instant application and claims 3-6 of copending Application No. 11/178,889 is that one recites an encoder and the other is not. However, this difference is not a patentable weight since the encoder is inherent in every data recording device for encoding the data before recording on a storage medium. Whether the encoder is positively recited in the body of the claim, found in the preamble of the claim or omitted is merely a selection between combination and subcombination of elements used in overall system and that would not make them patentable distinctions.

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8) Claim 11 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 8 of co-pending Application No. 11/178,889. Although the conflicting claims are not identical, they are not patentably distinct from each other because: the difference between claim 11 in this instant application and claim 8 of co-pending Application No. 11/178,889 is that one recites a method for recording data (preamble) and the other recites a method for interrupting data recording. However, this difference is not a patentable weight since the body of these claims recite the same structures and/or functions with each other and this would not make them a patentable distinction.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

9) Claim 12 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being

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unpatentable over claim 9 of co-pending Application No. 11/178,889.

Although the conflicting claims are not identical, they are not patentably distinct from each other because: the difference between claim 12 in this instant application and claim 9 of co-pending Application No. 11/178,889 is that one recites a method for recording data (preamble) and the other recites a method for interrupting data recording. However, this difference is not a patentable weight since the body of these claims recite the same structures and/or functions with each other and this would not make them a patentable distinction.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

10) Claim 13 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of co-pending Application No. 11/178,889. Although the conflicting claims are not identical, they are not patentably distinct from each other because: the difference between claim 13 in this instant application and claim 1 of co-pending Application No. 11/178,889 is that one recites a buffer underrun and a laser drive circuit and the other is not. However, this difference

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is not a patentable weight since the buffer underrun and laser drive circuit are inherent in every data recording device for detecting the underrun of buffer memory and controlling the power levels of laser beam. Whether the buffer underrun and laser drive circuit are positive recited in the body of the claim, found in the preamble of the claim or omitted is merely a selection between combination and subcombination of elements used in overall system and that would not making them patentable distinction.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

11) Claims 1 and 2 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 4 of co-pending Application No. 10/814,356. Although the conflicting claims are not identical, they are not patentably distinct from each other because: the different between claims 1 and 2 in this instant application and claim 4 of copending Application No. 10/814,356 is that one recites a data recorder (preamble) and the other recites a control circuit for data recorder. However, this different is not a patentable weight since the body of these claims recite the same structures and/or

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functions with each other and this would not make them a patentable distinction.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

12) Claims 3-6 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 of co-pending Application No. 10/814,356. Although the conflicting claims are not identical, they are not patentably distinct from each other because: the different between claims 3-6 in this instant application and claims 1-3 of copending Application No. 10/814,356 is that one recites a data recorder (preamble) and the other recites a control circuit for data recorder. However, this different is not a patentable weight since the body of these claims recite the same structures and/or functions with each other and this would not make them a patentable distinction.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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13) Claim 7 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims *1 and 2* of co-pending Application No. 10/814,356. Although the conflicting claims are not identical, they are not patentably distinct from each other because: the different between claim 7 in this instant application and claims *1 and 2* of copending Application No. 10/814,356 is that one recites a data recorder (preamble) and the other recites a control circuit for data recorder. However, this different is not a patentable weight since the body of these claims recite the same structures and/or functions with each other and this would not make them a patentable distinction.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

14) Claims 8-10 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 4 of co-pending Application No. 10/814,356. Although the conflicting claims are not identical, they are not patentably distinct from each other because: the different between claims 3-6 in this instant application and claim 4 of

copending Application No. 10/814,356 is that one recites an encoder and a buffer memory and the other is not. However, this different is not a patentable weight since the buffer memory and an encoder are inherent in every data recording device for temporary storing data during recording or reproducing and encoding the data before recording on a storage medium. Whether the buffer memory and encoder are positive recited in the body of the claim, found in the preamble of the claim or omitted is merely a selection between combination and subcombination of elements used in overall system and that would not making them patentable distinction.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

15) Claim 11 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 5 of co-pending Application No. 10/814,356. Although the conflicting claims are not identical, they are not patentably distinct from each other because: the different between claim 11 in this instant application and claim 5 of copending Application No. 10/814,356 is that one recites a method for recording data (preamble) and the other recites a method for interrupting

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data recording. However, this different is not a patentable weight since the body of these claims recite the same structures and/or functions with each other and this would not make them a patentable distinction.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

16) Claim 12 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 6-8 of co-pending Application No. 10/814,356. Although the conflicting claims are not identical, they are not patentably distinct from each other because: the different between claim 12 in this instant application and claims 6-8 of copending Application No. 10/814,356 is that one recites a method for recording data (preamble) and the other recites a method for interrupting data recording. However, this different is not a patentable weight since the body of these claims recite the same structures and/or functions with each other and this would not make them a patentable distinction.

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

17) Claim 13 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 4 of co-pending Application No. 10/814,356. Although the conflicting claims are not identical, they are not patentably distinct from each other because: the different between claim 13 in this instant application and claim 4 of copending Application No. 10/814,356 is that one recites a data recorder (preamble) and the other recites a controller for data recording. However, this different is not a patentable weight since the body of these claims recite the same structures and/or functions with each other and this would not make them a patentable distinction.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

18) Applicant's arguments with respect to claims 1-13 have been considered but are moot in view of the new ground(s) of rejection.

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19) Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAN XUAN DINH whose telephone number is (571)272-7586. The examiner can normally be reached on MONDAY-FRIDAY from 8:00AM to 5:00PM.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov/>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



TAN DINH
PRIMARY EXAMINER

November 18, 2005